

Application of: Woo Sung Lee  
Serial No.: 10/597,056  
Amendment A

**AMENDMENTS TO THE DRAWINGS:**

The attached sheet of drawings includes changes to FIG. 17. This sheet, which includes FIG. 17, replaces the original sheet including FIG. 17. Applicant adds the legend -- Prior Art -- to Fig. 17. No new matter has been added.

Attachments: Replacement sheet of drawings

### **REMARKS**

The amendments and remarks presented herein are believed to be fully responsive to the Office Action.

Claims 1-20 are pending in the present application. Claims 1-20 have been cancelled, without prejudice. Claims 21-35 have been added. No new matter has been added. The independent claims recited by the present application are claims 21 and 35.

### **OATH/DECLARATION**

The Office Action states that the declaration is defective because Applicant failed to properly note the amendment on the declaration and instead directed the declaration to the specification filed on January 27, 2005.

Applicant respectfully submits a new Declaration herewith in accordance with the Office Action.

### **DRAWING**

The Office Action requires Figure 17 to be designated by a legend such as –Prior Art-. Applicant respectfully amends Fig. 17 by adding the legend “Prior Art”.

### **SPECIFICATION OBJECTIONS:**

The Office Action states that the abstract of the disclosure is objected because the abstract was not provided on a separate sheet and because the first sentence includes a self evident clause, *the present invention relates to....*

According to Examiner Note for ¶6.12 and ¶6.16.01 of MPEP §608.01(b), 37 CFR 1.72(b) should not be used during the national stage prosecution of international applications ("371 applications") if an abstract was published with the international application under PCT Article 21. As such, Applicant respectfully requests the Examiner to reconsider the objection.

In addition, the Office Action states that the title of the invention is also objected because it is not descriptive. Applicant respectfully amends the title of the invention as following:

METHOD AND SYSTEM FOR PROVIDING ACCOUNT INFORMATION ON  
KEYWORD ADVERTISING

**CLAIM REJECTIONS:**

**A. Claim Rejections under 35 U.S.C. § 112**

The Office Action notes that claims 1-20 are indefinite for failing to particularly point out and distinctly claim the subject matter because they appear to contain incorrect English translation. Applicant respectfully adds claims 21-35 to correct faulty English translation and to particularly point out and distinctly claim the subject matter in accordance with the Examiner's rejections. Further, the Office Action states that there is insufficient antecedent basis in the claims 1-20.

Since claims 1-20 have been canceled without prejudice, however, the rejections thereof are moot.

Furthermore, Applicant respectfully corrects the insufficient antecedent basis for the new claims 21-35 in accordance with the Examiner's rejections.

In addition, the Office Action states that a few terms, including terms “just” and “upwards”, render the claim indefinite. Applicant respectfully corrects the indefinite terms in the newly added claims 21-35. No new matter is added.

### **B. Claim Rejections under 35 U.S.C. § 101**

The Office Action states that the claimed invention of claims 19 and 20 is directed to non-statutory subject matter because the claims do not define a computer readable record medium.

Since claims 19 and 20 have been canceled without prejudice, however, the rejection thereof is moot.

Further, Applicants respectfully correct them in a newly added claim 35 in accordance with the Examiner’s recommendations.

### **C. Claim Rejections under 35 U.S.C. § 102**

A claim is anticipated under 35 U.S.C. 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. v. Union Oil Company, 814 F.2d 628 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim of the invention. Richardson v. Suzuki Motor Company, 868 F.2d 1226, 1236 (Fed. Cir. 1989). With regard to “inherency,” the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence must make clear that

the missing descriptive matter is necessarily present in the thing described in the reference and that it would be recognized by persons of ordinary skill. Inherency, however, may be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Also, a reference cannot anticipate a claim if there is any structural difference, even if the prior art device performs the function of the claim. In re Ruskin, 347 F.2d 843, 146 U.S.P.Q. 211 (CCPA 1965).

The Office Action states that claims 1-9, 13, and 16-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Cheung et al., U.S. Patent No. 7,043,471 (hereinafter "Cheung"). Applicants respectfully traverse these rejections. Further, claims 1-20 have been cancelled, without prejudice. Thus, the rejections thereof are moot.

Even assuming, for the sake of argument, that the rejections stated in the Office Action apply to the newly added claims 21-35, Cheung fails to disclose limitations recited in the independent claims 21 and 35 of the present application. Cheung fails to disclose each and every element recited in the independent claims 21 and 35 of the present application. In particular, both the claims 21 and 35 recite the following limitations:

if the actual cost exceeds the predicted expense, providing the advertiser with a free advertising period during the remaining time period of the first advertising period without charging beyond the predicted expense, the free advertising period being a period of time in which advertisings are served but the advertiser's account for the advertisement is depleted.

As the Office Action notes, Cheung does not teach or suggest the free advertising period recited in the claims 21 and 35. See the Office Action, page 13. As such, Cheung fails to

disclose each and every element recited in Claims 21 and 35 of the present application.

Therefore, claims 21 and 35 of the present invention are now in condition for allowance.

Further, claims 22-33 depend from independent claim 21 and, as such, are in allowable condition since claim 21 is clearly allowable over the cited prior art.

#### **D. Claim Rejection under 35 U.S.C. § 103**

**LEGAL PRINCIPLE** - To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claim combination or combine the references and the reasonable expectation of success must both be found in the prior art and not based on the Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

With regard to the first criteria for a suggestion or motivation to modify or combine references, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000). Courts and patent examiners should determine whether needs or problems known in the field and addressed by the prior art references can

provide a reason for combining the elements in the manner claimed. KSR Intern. Co. v. Teleflex Inc., No. 04-1350, 2007 WL 1237837, at 4 (Apr. 30, 2007). "In formulating a rejection under 35 USC § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." Memo on KSR Decision to Examiners issued by the United States Patent and Trademark Office, May 4, 2007. The prior art is not sufficient to establish obviousness without some objective reason to combine the teachings of the references. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000), also see In re Sang Su Lee, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action states that claims 10-12 and 14-15 stand rejected under 35 U.S.C. 103(a), as being unpatentable over Cheung.

Applicants respectfully traverse these rejections. Further, claims 1-20 have been cancelled, without prejudice. Thus, the rejections thereof are moot.

Even assuming, for the sake of argument, that the rejections stated in the Office Action apply to the newly added claims 21-35, Cheung does not teach or suggest limitations recited in the independent claims 21 and 35 of the present application and the Examiner's Official Notice still fails to remedy the deficiencies of Cheung in teaching all the elements and limitations of the claims of the present invention.

As discussed above, Cheung fails to disclose the following limitations in claims 21 and 35 of the present application:

if the actual cost exceeds the predicted expense, providing the advertiser with a free advertising period during the remaining time period of the first advertising period without charging beyond the predicted expense, the free advertising period being a period of time in which advertisings are served but the advertiser's account for the advertisement is depleted.

The Office Action also notes that “Cheung does not use the words free advertising period because when a reserve fund is empty. Cheung contemplates either no longer displaying the advertisement or invoicing the advertiser. ... Rather than allowing free advertising, Cheung takes the position that free advertisements are a defect in the art [] and prevents them from being distributed server....” See Office Action, page 13 (**emphasis added**).

Nonetheless, the Office Action argues that “it would have been obvious to one having ordinary skill in the art the invention was made to reasonably disagree with Cheung’s position that free advertisements in this situation are a defect of the prior art and be contrarily motivated to award free clicks....” See Office Action, page 13-14 (**emphasis added**).

As the Office Action admits, teachings of Cheung are contrary to the suggestion of the claimed invention. (Cheung’s position that free advertisements in this situation are a defect). At best, Cheung is nothing but an invitation to experiment with contrary direction on how to design free advertisement for internet advertising charging models associated with a click-through. There is simply no direction in Cheung to the present invention. The only direction is through the application of forbidden hindsight.

Furthermore, Cheung teaches away from a combination with any prior art reference or the Official Notice taken by the Office Action. There is no motivation to combine if a reference teaches away from its combination with another source. Tec Air., Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set forth in the reference, or would be led in a direction divergent from the path that was taken by the applicant ... [or] if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the device.” Id.



(quoting In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994)). A prior art reference may teach away impliedly when a modification or combination would render inoperable the invention disclosed in the reference. In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984).

Likewise, in this case, Cheung teaches away from its combination with the free advertisements reconstructed by the Office Action. The claimed invention suggests the free advertising period that is a period of time in which advertisings are served but the advertiser's account for the advertisement is depleted if the actual cost exceeds the predicted expense provided by a service provider, on which the advertiser relied on. As the Office Action admits, however, **the free advertisements in the internet advertising charging models associated with a click-through is a defect according to the Cheung's position.** Cheung cannot be modified contrary to the teachings of the same because a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. As such, Cheung does not teach or suggest limitations recited in the independent claims 21 and 35 of the present application.

Claims 22-33 depend from independent claim 21 and, as such, are in allowable condition since claim 30 is clearly allowable over the cited prior art.

In light of the aforementioned amendments and discussion, Applicant respectfully submits that the application is now in condition for allowance.

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions

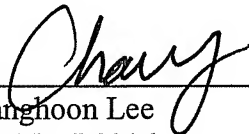
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regarding the present amendment, it is respectfully requested that the Examiner please telephone  
Applicant's undersigned attorney in this regard.

Respectfully submitted,

Date:

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